

REMARKS

By this Amendment, relative to prior amendments to this application, Applicant has amended the specification and claim 7. As outlined in more detail herein, these amendments do not add any new matter.

Claims 1-9, 11-28, 30, 31, 33-69, and 78-91 are pending on the merits (claims 10, 29, 32, and 70-77 were previously canceled). All of those pending claims have been rejected in the Office Action of June 30, 2011. For at least the reasons outlined herein, Applicant respectfully requests reconsideration and withdrawal of the claim rejections included in the Office Action, and indication that claims 1-9, 11-28, 30, 31, 33-69, and 78-91 are allowable.

I. Statement of the Substance of the Interview Conducted October 12, 2011

Applicant appreciates the courtesy and consideration extended by Examiner Nicolas to Applicant's representative during the telephone interview conducted on October 12, 2011. During the interview, at least some of the issues addressed herein were discussed.

II. Amendment to the Specification

In accordance with M.P.E.P. § 1411.01 and 37 C.F.R. § 1.321(a), Applicant has amended the specification to incorporate the change included in the Certificate of Correction issued October 9, 2001, for the patent on which this reissue application is based ("the patent"). In particular, "SEBS" has been deleted from col. 6, line 67, as indicated in the Certificate of Correction. In accordance with M.P.E.P. § 1411.01, this amendment has not been indicated with underlining or bracketing because it is retroactively already part of the patent.

III. Claim Amendments

A. Original Patent Claims

Original patent claims 7, 8, 11, 12, and 18, have been amended, as follows:

In claim 7, line 3, "SEBS" has been replaced with "styrene-ethylene butadiene."

This amendment is supported at least at column 6, line 67, of the patent.

Claims 8, 11, 12, and 18 were previously amended in the Amendment filed June 6, 2008, and the Supplemental Response to Office Action filed August 10, 2009, as follows:

In claim 8, line 12, the subject matter previously recited in original patent claim 10 was added, as follows:

-- wherein the body has a transverse partition separating a first space defining said reservoir from a second space surmounting the first space, said second space containing said pump mounted in said partition, the actuating element mounted on said pump, the outlet element and the conduit forming the flexible connection. --

In the Office Action of February 6, 2008, the Examiner indicated that such an amendment would render claim 8 allowable. Support for this amendment is found at least in original patent claim 10.

Claims 11 and 12, which previously depended from claim 10, were amended to depend from amended claim 8, and support for these changes is found at least in original patent claims 11 and 12, respectively.

In claim 18, line 10, the following subject matter has been inserted:

-- wherein the body has a transverse partition separating a first space from a second space --

The subject matter recited in this amendment is supported at least in original patent claim 1.

B. Added Claims

Claims 30, 33, 34, 43, 55, 78, 83, 84, 86, 87, 90, and 91, which were added by the Preliminary Amendment and Remarks filed November 9, 2001 ("Preliminary Amendment"), were previously amended in the Amendment filed June 6, 2008, and the Supplemental Response to Office Action filed August 10, 2009, as follows:

Claim 30, line 5, "the" was changed to "a";

Claim 30, line 10, "the" was changed to "a";

Claim 30, line 11, "the" was changed to "an";

In claim 30, at line 13, the subject matter previously recited in added claim 32 was incorporated into claim 30, as follows:

-- wherein said wall defines a space above said reservoir having an open end opposite said reservoir, said container having a traverse partition separating said reservoir from said space, said space containing a portion of said pump, said outlet element, and said conduit. --

(The Examiner indicated that such an amendment would render claim 30 allowable.

Support for this amendment is found at least in claim 32, which was added in the Preliminary Amendment.)

Claim 33, line 1, "32" was changed to "30";

Claim 34, line 1, "32" was changed to "30";

Claim 43, line 6, "the" was changed to "a";

Claim 43, line 11, "the" was changed to "an";

Claim 43, line 12, "the" was changed to "an";

Claim 55, line 5, "the" was changed to "a";

Claim 55, line 10, "the" was changed to "an";

Claim 55, line 11, "the" was changed to "an";

Claim 78, line 6, "the" was changed to "a";

Claim 83, line 5, "the" was changed to "a";

Claim 84, line 5, "the" was changed to "a";

Claim 86, line 5, "the" was changed to "a";

Claim 87, line 5, "the" was changed to "a";

Claim 90, line 5, "the" was changed to "a";

Claim 90, line 11, "the" was changed to "an";

Claim 90, line 12, "the" was changed to "an";

Claim 91, line 5, "the" was changed to "a";

Claim 91, line 11, "the" was changed to "an"; and

Claim 91, line 12, "the" was changed to "an."

The amendments to claims 33, 34, 43, 55, 78, 83, 84, 86, 87, 90, and 91 were made to change the dependency of the claims or to correct minor informalities. Such amendments are not intended to narrow the scope of these claims, and these claims should be interpreted in that light. In addition, due to the nature of these amendments, Applicant respectfully submits that the subject matter of these amendments is supported in the patent.

The amendments made to claims 30, 33, 34, 43, 55, 78, 83, 84, 86, 87, 90, and 91 are reflected in the listing of claims included in this Amendment.

IV. Information Disclosure Statement

In accordance with M.P.E.P. § 1406, Applicant submits concurrently with this Amendment, an Information Disclosure Statement under 37 C.F.R. §§ 1.97 and 1.98, which cites all of the references of record in the patent on which this reissue application is based that have not already been cited in this reissue application.

V. Claim Rejection Under 35 U.S.C. § 251

Claims 78-85 were rejected under 35 U.S.C. § 251 based on an assertion of “an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.” Office Action at 2. The rejection asserts that “prosecution of the patent indicates that there are 6 different reasons why the claims of the patent[] were allowed; thus there are 6 surrender generating limitations.” Id. at 3. Thereafter, the rejection asserts that “any newly added claim, in order to not violate recapture, must contain one of the 6 limitations,” and that “[i]f the surrendered subject matter has been entirely eliminated from a claim in the reissue application, or has been in any way broadened, then it is guilty of recapture and must be rejected under 35 USC 251.” Id.

Applicant respectfully traverses the § 251 rejection of claims 78-85 because the broadening of those claims relative to the patent claims does not improperly recapture surrendered subject matter. According to the M.P.E.P., a three step test must be used to determine whether a reissue claim violates the rule against recapture of surrendered subject matter. § 1412.02(l). The three steps are as follows:

- (1) . . . determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims;

(2) . . . determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and

(3) . . . determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.

Id. (citations omitted). If, under step 1, the reissue claim has been broadened, step 2 requires a two sub-step analysis. Id. In particular, if a reissue claim has been broadened, the analysis is based on the following two sub-steps:

(A) . . . determine whether applicant surrendered any subject matter in the prosecution of the original application that became the patent to be reissued [; and]

(B) If applicant did surrender subject matter in the original application prosecution, the examiner must then determine whether any of the broadening of the reissue claims is in the area of the surrendered subject matter. The examiner must analyze all of the broadening aspects of reissue claims to determine if any of the omitted/broadened limitation(s) are directed to limitations relied upon by applicant in the original application to make the claims allowable over the art.

§ 1412.02(l)(B)(1). Regarding part B of the two sub-steps, the M.P.E.P. advises that when comparing reissue claims to patent claims,

If the reissue claims are narrower in scope than the claims canceled from the original application by inclusion of *the entirety of the limitation added to define the original application claims over the art, there will be no recapture, even if the reissue claims are broader than the canceled claims in some other aspect (i.e., an aspect not related to the surrender made in the original application).*

§ 1412.02(l)(C)(1)(b) (second emphasis added). The M.P.E.P. provides the following example of this situation:

combination ABZ was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABZC (after which the patent

issued). The reissue claims are then directed to combination ABC (i.e., element Z is deleted from the canceled claims, while element C remains present). The ABC claims of the reissue are *narrower* in scope as compared to the canceled-from-the-original-application claim subject matter ABZ *in respect to the addition of C* (which was added in the application to overcome the art), and they retain surrender-generating limitation C; thus, there is no recapture.

Id. Thus, even if a reissue claim is broadened relative to a corresponding patent claim, it is not recapture if the broadening is related to an aspect of the claims not related to the subject matter added to the patent claims during prosecution to obtain allowance.

Applicant respectfully traverses the § 251 recapture rejection of claims 78-85 because, although those reissue claims have been broadened relative to corresponding patent claims, they have not been broadened in an aspect relative to subject matter surrendered during prosecution of the original application. In particular, the reissue claims have been broadened by deleting subject matter not related to the subject matter added during prosecution of the original application.

Of the rejected claims, claims 78, 83, and 84 are independent claims, with claims 79-82 depending from claim 78, and claim 85 depending from claim 84. Independent claim 78 corresponds to independent claim 1 of the patent. Independent claim 83 corresponds to independent claim 18 of the patent. Finally, independent claim 84 corresponds to independent claim 19 of the patent. Independent claim 1 of the patent corresponds to claim 14 of the original application. Independent claim 18 of the patent corresponds to claim 4 of the original application. And independent claim 19 of the patent corresponds to claim 5 of the original application. The table provided below shows the correspondence between the reissue claims, the patent claims, and the claims of the original application.

Reissue Claim	Patent Claim	Claim of the Original Application
78	1	14
83	18	4
84	19	5

During prosecution of the original application, the Office Action dated July 27, 1999 indicated that claims 4 and 14 of the original application contained allowable subject matter and that those claims would be allowed if rewritten in independent form, including the subject matter of the base claim and any intervening claims. Claims 4 and 14 depended from independent claim 1 of the original application. Claim 5 of the original application, a dependent claim, was rejected under 35 U.S.C. § 112, first paragraph, but was not rejected under either § 102 or § 103. Claim 5 depended from independent claim 1 of the original application.

In the response to the Office Action dated July 27, 2011, which was filed September 17, 1999, claims 4, 5, and 14 were amended to place those claims in independent form, and the rejection of claim 5 under § 112, first paragraph, was traversed. The response resulted in the original application being allowed, resulting in patent claims 1, 18, and 19 (i.e., claims 14, 4, and 5 renumbered, respectively).

Thus, independent claims 1, 18, and 19 of the patent resulted from combining the subject matter of independent claim 1 of the original application with the subject matter, respectively, of claims 14, 4, and 5 of the original application. Applicant respectfully submits that reissue claims 78, 83, and 84 include the subject matter recited in

claims 14, 4, and 5 of the original application in a slightly modified form. The form of the subject matter was modified slightly in order to conform that subject matter to changes to other aspects of reissue claims 78, 83, and 84. Thus, reissue claims 78, 83, and 84 do not improperly recapture surrendered subject matter.

The table below provides a side-by-side comparison of patent claims 1, 18, and 19 and corresponding reissue claims 78, 83, and 84. The relevant portions of claims 1, 18, 19, 78, 83, and 84 have been underlined for clarity.

Claims 1, 18, and 19 of the Patent	Claims 78, 83, and 84 of the Reissue Application
<p>1. A unit for packaging and dispensing a liquid or semi-liquid product, comprising:</p> <p>a body forming a reservoir for the product and having a fixed portion surmounting the reservoir;</p> <p>a pump surmounting the reservoir; an actuating element mounted for actuating the pump; and</p> <p>a product outlet element having at least one opening and connected to the pump by a conduit forming a flexible connection,</p> <p>wherein the outlet element is held substantially immovably in position on the fixed portion of the body, and</p> <p>wherein the actuating element is mounted independent of said fixed portion of the body,</p> <p>wherein the body has a transverse partition separating a first space defining said reservoir from a second space surmounting the first space, said second space containing said pump mounted in said partition, the actuating element mounted on said pump, the outlet element and the conduit forming the flexible connection,</p> <p><u>wherein the second space has an end opposite said partition,</u></p> <p>further comprising a protective element closing said</p>	<p>78. A unit for packaging and dispensing a liquid or semi-liquid product, comprising:</p> <p>a container forming a reservoir for the product;</p> <p><u>a wall extending above and in fixed position with respect to said container, said wall defining a space above said reservoir having an open end opposite said reservoir;</u></p> <p>a pump mounted to a top of said container, said pump including an actuating element, mounted independent of said wall and said container, for operating said pump;</p> <p>a product outlet element held substantially immovable with respect to said wall;</p> <p>a conduit forming a flexible connection between said pump and said outlet element; and</p> <p><u>a protective element closing said open end of said space defined by said wall, wherein at least one portion of said protective element is engagable with said actuating element and is formed by a material sufficiently flexible to permit operation of said actuating element through said protective element.</u></p>

<p><u>end, wherein at least one portion of said protective element is engagable with the actuating element and is formed by a flexible material to permit actuating said actuating element through said protective element.</u></p>	
<p>18. A unit for packaging and dispensing a liquid or semi-liquid product, comprising:</p> <p>a body forming a reservoir for the product and having a fixed portion surmounting the reservoir;</p> <p>a pump surmounting the reservoir;</p> <p>an actuating element mounted for actuating the pump; and</p> <p>an outlet nozzle having at least one opening and connected to the pump by a conduit forming a flexible connection,</p> <p>wherein the outlet nozzle is held substantially immovably in position on the fixed portion of the body,</p> <p>wherein the actuating element is mounted independent of said fixed portion of the body,</p> <p><u>wherein the outlet nozzle is disposed substantially immovably at the bottom of a cutout formed in a side wall of the second space, said cutout opening out on a free edge of the second space situated opposite the transverse partition.</u></p>	<p>83. A unit for packaging and dispensing a liquid or semi-liquid product, comprising:</p> <p><u>a container forming a reservoir for the product;</u></p> <p><u>a wall extending above and in fixed position with respect to said container;</u></p> <p>a pump mounted to a top of said container;</p> <p>an actuating element mounted for actuating the pump; and</p> <p>an outlet nozzle having at least one opening and being flow connected to said pump by a conduit forming a flexible connection,</p> <p>wherein said outlet nozzle is held substantially immovably in position with respect to said wall,</p> <p>wherein said actuating element is mounted independent of said wall and said container,</p> <p><u>wherein said outlet nozzle is disposed substantially immovably at the bottom of a cutout formed in said wall, said cutout opening out on a free edge of said wall situated opposite said container.</u></p>
<p>19. A unit for packaging and dispensing a liquid or semi-liquid product, comprising:</p> <p>a body forming a reservoir for the product and having a fixed portion surmounting the reservoir;</p> <p>a pump surmounting the reservoir;</p> <p>an actuating element mounted for actuating the pump; and</p> <p>a product outlet element having at least one opening and connected to the pump by a conduit forming a flexible connection,</p> <p>wherein the outlet element is held substantially</p>	<p>84. A unit for packaging and dispensing a liquid or semi-liquid product, comprising:</p> <p><u>a container forming a reservoir for the product;</u></p> <p><u>a wall extending above and in fixed position with respect to said container;</u></p> <p>a pump mounted to a top of said container, said pump including an actuating element mounted for actuating said pump; and</p> <p>a product outlet element having at least one opening and being flow connected to said pump by a conduit forming a flexible connection,</p>

<p>immovably in position on the fixed portion of the body,</p> <p>wherein the actuating element is mounted independent of said fixed portion of the body,</p> <p><u>wherein the outlet element is mounted inside a housing communicating with the conduit forming the flexible connection,</u></p> <p><u>wherein the actuating element, the housing and the flexible conduit form a single molded part.</u></p>	<p>wherein said outlet element is held substantially immovably in position with respect to said wall,</p> <p>wherein said actuating element is mounted independent of said wall and said container, and</p> <p><u>wherein said actuating element, said outlet element, and said flexible conduit form a single molded part.</u></p>
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As explained in more detail below, the side-by-side comparison shows that reissue claims 78, 83, and 84 include the subject matter from claims 14, 4, and 5, respectively of the original application.

A. Comparison of Reissue Claim 78 and Patent Claim 1

Independent claim 78 of the reissue application recites the following subject matter:

a wall extending above and in fixed position with respect to said container, said wall defining a space above said reservoir having an open end opposite said reservoir; . . .

and

a protective element closing said open end of said space defined by said wall, wherein at least one portion of said protective element is engagable with said actuating element and is formed by a material sufficiently flexible to permit operation of said actuating element through said protective element.

Claim 14 of the original application, which was added to independent claim 1 of the original application resulting in patent claim 1, recited in pertinent part:

wherein the second space has an end opposite said partition, further comprising a protective element closing said end, wherein at least one portion of said protective element is engagable with the actuating element and is formed by a

flexible material to permit actuating said actuating element through said protective element.

As can be seen from a comparison of this corresponding subject matter, the only differences are unrelated to the subject matter recited in claim 14 of the original application. For example, whereas the above-quoted portion of patent claim 1 refers to a "partition," reissue claim 78 recites a "wall." Thus, the differences between reissue claim 78 and patent claim 1 do not constitute improper recapture of surrendered subject matter.

B. Comparison of Reissue Claim 83 and Patent Claim 18

Independent claim 83 of the reissue application recites the following subject matter:

wherein said outlet nozzle is disposed substantially immovably at the bottom of a cutout formed in said wall, said cutout opening out on a free edge of said wall situated opposite said container.

Claim 4 of the original application, which was added to independent claim 1 of the original application resulting in patent claim 18, recited in pertinent part:

wherein the outlet nozzle is disposed substantially immovably at the bottom of a cutout formed in a side wall of the second space, said cutout opening out on a free edge of the second space situated opposite the transverse partition.

As can be seen from a comparison of this corresponding subject matter, the only differences are unrelated to the subject matter recited in claim 4 of the original application. For example, whereas the above-quoted portion of patent claim 18 refers to a "second space," reissue claim 83 does not recite a "second space." Thus, the differences between reissue claim 83 and patent claim 18 do not constitute improper recapture of surrendered subject matter.

C. Comparison of Reissue Claim 84 and Patent Claim 19

Independent claim 84 of the reissue application recites the following subject matter:

a container forming a reservoir for the product;
a wall extending above and in fixed position with respect to said container; . . .
a product outlet element having at least one opening and being flow connected to [a] pump by a conduit forming a flexible connection; . . .
wherein said actuating element, said outlet element, and said flexible conduit form a single molded part.

Claim 5 of the original application, which was added to independent claim 1 of the original application resulting in patent claim 19, recited in pertinent part:

wherein the outlet element is mounted inside a housing communicating with the conduit forming the flexible connection, wherein the actuating element, the housing and the flexible conduit form a single molded part.

As can be seen from a comparison of this corresponding subject matter, the only differences are unrelated to the subject matter recited in claim 5 of the original application. For example, whereas the above-quoted portion of patent claim 19 refers to a "housing," reissue claim 84 does not recite a "housing." Thus, the differences between reissue claim 84 and patent claim 19 do not constitute improper recapture of surrendered subject matter.

For at least the above-outlined reasons, reissue claims 78-85 do not improperly recapture subject matter surrendered during prosecution of the original application. Therefore, Applicant respectfully requests reconsideration and withdrawal of the

rejection of claims 78-85 under 35 U.S.C. § 251 based on purported recapture of surrendered subject matter.

VI. Objection to the Reissue Oath/Declaration

The reissue oath/declaration filed with the application was objected to as being defective based on an assertion that "it fails to contain the statement required under 37 CFR 1.175 (a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid." Office Action at 3 (citation omitted). The rejection further asserts that "Applicant needs to further state 'by reason of patentee having claim[ed] more than he had a right to claim.'" Id. (citation omitted). During the interview conducted October 12, 2011, in an attempt to clarify this objection, the Examiner asserted that because patent claim 8 was amended in a narrowing fashion, the patentee had previously claimed more than he had a right to claims, and therefore, the reissue oath/declaration should have stated that the "patent wholly or partly defective by reason of patentee claiming more than he had a right to claim." The Examiner further asserted that because paragraph 6 of the Declaration of Thierry Ponton filed February 8, 2005, declared, "I believe that U.S. Patent No. 6,089,410 is partially inoperative by reason of my having claimed less than I had a right to claim," and did not include a statement that he claimed more than he had a right to claim, the reissue oath/declaration is defective.

As explained below, Applicant does not believe this objection is proper. However, in the interest of expediting issuance of a Notice of Allowance for this application, Applicant will submit in the near future a supplemental reissue declaration declaring, among other things, that patentee claimed more than he had a right to claim.

Applicant believes the objection to the reissue oath/declaration is improper at least because, subsequent to amending patent claim 8, Applicant filed a Supplemental Reissue Declaration on July 6, 2010, which covered the amendment to claim 8 on which the objection is apparently based. In particular, in the Supplemental Reissue Declaration, Applicant declared, "Every error in the patent which was corrected in the present reissue application, and which is not covered by the Declaration filed February 8, 2005, in this application, arose without any deceptive intention on the part of the applicant." Thus, according to 37 C.F.R. § 1.175, the Supplemental Reissue Declaration covers the amendment to claim 8. As a result, the objection to the reissue oath/declaration is improper and should be withdrawn.

VII. Claim Rejection Based on Purportedly Defective Reissue Oath/Declaration

Claims 1-9, 11-28, 30, 31, 33-69, and 78-91 were rejected based on the purportedly defective reissue oath/declaration. Office Action at 3. For at least the reasons outlined above, the Reissue Declaration and Supplemental Reissue Declaration previously filed in this application are not defective. Thus, this claim rejection based on a purportedly defective reissue oath/declaration should be withdrawn. As noted above, however, because this response includes amendments to the specification and patent claim 7, and in the interest of expediting issuance of a Notice of Allowance for this application, Applicant will submit in the near future a second supplemental reissue declaration declaring, among other things, that patentee claimed more than he had a right to claim. For at least these reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-9, 11-28, 30, 31,

33-69, and 78-91 under § 251 based on a purportedly defective reissue oath/declaration upon receipt of the second supplemental reissue declaration.

VIII. Claim Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 7 was rejected under 35 U.S.C. § 112, second paragraph, based on an assertion that “[i]n claim 7, line 3, the claimed limitation ‘SEBS’ is unclear,” and that “the claimed limitation ‘SEBS’ is not supported in the application.” Office Action at 4.

Although Applicant does not believe that this claim rejection is necessarily proper, Applicant has amended claim 7 to replace the abbreviation, “SEBS,” with “styrene-ethylene butadiene.” This amendment is supported at least at column 6, line 67, of the patent. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 7 under § 112, second paragraph. In addition, because Applicant is merely replacing an abbreviation with the words abbreviated, this amendment does not narrow the scope of claim 7, and claim 7 should be interpreted accordingly.

IX. Conclusion

For at least the reasons outlined above, Applicant’s claims 1-9, 11-28, 30, 31, 33-69, and 78-91 should be allowable.

Applicant respectfully requests reconsideration of this application, withdrawal of the objection and claim rejections, and allowance of claims 1-9, 11-28, 30, 31, 33-69, and 78-91.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant’s undersigned attorney.


Applicant respectfully submits that the Office Action of June 30, 2011, contains a number of assertions concerning the disclosure and claims of this reissue application. Regardless of whether those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this Amendment and charge any required fees to our Deposit Account 06-0916.

Respectfully submitted,

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Dated: October 31, 2011

By: 
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